

Preliminary Amendment  
U.S. Patent Application S.N. 10/073,766  
Page 5 of 9

Remarks:

Applicant appreciates the allowance of claims 5-8. Applicant has cancelled claims 12-15, due to the restriction requirement, and reserves the right to make those claims in a divisional application. Claim 16 should not have been grouped with the method claims, as it is dependent on claim 4, which is an apparatus claim. Therefore, claim 16 remains in this application, and Applicant respectfully requests that it be examined along with the other pending claims.

The present invention provides an arrangement that permits a surgeon to comfortably join together two tissues using only one hand. This is not accomplished or suggested by the prior art.

U.S. Patent 5,449,374 "Dunn" is intended to be used to spread tissues apart, not to pull them together. It uses two pairs of forceps, which operate in different planes of motion, and hinges those two pairs of forceps together. Figure 9 of the Dunn patent provides a hinge 124 and a spring 130, which connect the two pairs of forceps together. Neither the hinge nor the spring fixes the positions of the forceps legs relative to each other, since the spring 130 is intended to permit flexing, and the hinge joint permits pivoting. The surgeon presses down (into the paper) on the hinge area 124 to close both pairs of forceps at the same time and then squeezes the forceps together at the top 126, causing the pairs of forceps to pivot relative to each other about the hinge joint 124, so that the top portions of the pairs move toward each other, causing the bottom portions to move away from each other in order to spread the tissues apart, as indicated by the arrows.

## Amendment

U.S. Patent Application S.N. 10/073,766

Page 6 of 9

Since the Dunn arrangement requires both pairs of forceps to be closed onto the tissues at the same time, it is not clear how it could be used to join tissues together. The present invention contemplates being able to close one of the pairs of forceps onto a first tissue, pull that tissue toward a second tissue, and then close the forceps onto the second tissue, bringing the two tissues together. That is an entirely different function from what is taught by Dunn and from what is enabled by the structure of the Dunn forceps.

U.S. Patent 5,520,704 "Castro" is intended to pull tissues together and has two pairs of forceps which operate in the same plane of motion. However, it is difficult and awkward to use. The inner legs of the two pairs are connected together to form a single leg 14. The surgeon first grasps a first tissue between the legs 12 and 14, pushing down on the button 22 and locking those legs together using the locking mechanism 40. Then, the surgeon pulls the first tissue toward a second tissue and uses the second pair of forceps, pressing together the legs 16 and 14 to grasp the second tissue. This requires the surgeon to shift his hand, first pressing on the button 22, to press together and lock the first pair of forceps, and then pressing elsewhere to close together the second pair of forceps. This arrangement does not allow the surgeon to have control over and to individually adjust the amount of clamping pressure being applied on both pairs of forceps at the same time.

Claims 9-11 were rejected as anticipated by Dunn. Claim 9 has been amended to require the connection to fix the inner legs relative to each other adjacent to their gripper ends. Assuming that one leg on each pair of forceps is designated as the "inner leg", neither the hinge connection 124 nor the spring connection 130 of Dunn fixes the inner legs relative to each other adjacent to their gripper ends. In fact, both the hinge

Preliminary Amendment  
U.S. Patent Application S.N. 10/073,766  
Page 7 of 9

connection 124 and the spring connection 130 are intended to permit the positions of the legs adjacent to the gripper ends to change in order to spread apart the tissue. The pivoting of the forceps about the hinge 124 causes the relative positions of the inner legs to change in the area of the gripper ends. The spring 130 does not restrict that pivoting motion so as to fix the inner legs as currently claimed. Therefore, claim 9 recites an invention that is both novel and unobvious in view of the prior art.

Claim 10 has also been amended to require the spacer mounted on the inner legs above said connection to maintain a fixed spacing between the inner legs. Again, the spring 130 does not maintain a fixed spacing between the inner legs as claimed, nor does it suggest a fixed spacing, since the device would not function for its intended purpose if the spacing remained fixed.

Claim 11 depends from claim 10 and recites that the connection orients the first and second pairs of forceps so that they both operate in the same plane of motion. In Dunn, the two pairs of forceps operate in two different planes of motion, each of which is perpendicular to the paper. They do not operate in the same plane as required by this claim.

Claims 1-4 and 11 were rejected based on an obvious combination of Castro and Dunn. Castro has joined together the inner legs to form a single leg 14. The clamping together of the legs is conducted entirely from the top and bottom, i.e. by pushing on the button 22, and it is not contemplated that the inner leg 14 should be split apart to provide room for the surgeon to put a finger in between. It is not clear what would motivate anyone to add the spring of Dunn to the device of Castro, or, if adding such a spring, where it would be added. It could not be added to form a space between the inner legs,

Preliminary Amendment  
U.S. Patent Application S.N. 10/073,766  
Page 8 of 9

because the inner legs of Castro are united to form a single leg 14. Adding a spring to this device would not suddenly create a space between inner legs. It would first be necessary to split the leg 14 into two portions at the upper end in order to create a space. Adding the spring of Dunn would not achieve this. While it would be possible to add a spring between any two of the legs 16, 14, 12 of Castro, this would not create a space between the upper ends of the inner legs as claimed. Since the combination of these references would not form the claimed invention, the claimed invention cannot be obvious in view of these references.

Claim 2 depends from claim 1 and says that the connection between the inner legs is adjacent to the lower ends, and further comprising a spacer mounted on the inner legs above the connection to hold the inner legs apart above the connection. Again, adding a spring would not create the claimed spacer. It might add a place to put a finger, but it would not create a spacer to hold the inner legs apart above the connection as claimed.

Claim 3 recites that the spacer includes a ring fixed to both of the inner legs. Again, since there is no space between the inner legs of Castro, there cannot be a spacer that holds the legs apart, so there cannot be a spacer in the form of a ring that holds the legs apart as claimed.

Claim 4 depends from claim 1 and recites that the connection which joins together the inner legs is a spacer, holding the inner legs apart. As was explained above, adding the spring of Dunn to the Castro device would not create such a spacer.

Claim 16 depends from claim 4 and recites that the inner legs are further connected adjacent their gripper ends. In the Castro reference, the inner legs are connected together for their entire length, forming a single leg, so they are connected

Preliminary Amendment  
• U.S. Patent Application S.N. 10/073,766  
Page 9 of 9

adjacent their gripper ends. However, the proposed combination of Castro and Dunn would not meet the other limitations of this claim, as explained above.

Since all the claims in the present application recite an invention that is both novel and unobvious in view of the prior art, Applicant respectfully requests allowance of all the claims currently pending. If there are any remaining issues that need to be resolved before an allowance can be issued, Applicant's attorney would appreciate a phone call from the Examiner in order to expedite their resolution.

Respectfully submitted,



Theresa Fritz Camoriano  
Reg. No. 30,038  
Camoriano and Associates  
8225 Shelbyville Road  
Louisville KY 40222  
phone 502-423-9850  
fax 502-426-1167